

**Remarks**

This Application has been carefully reviewed in light of the Office Action mailed August 11, 2004. Applicant has amended Claims 5-7, 16, 22, 24-27, and 33 to correct typographical errors present in these claims. Applicant has also made clarifying amendments to Claim 15. None of these amendments are narrowing and none are made in relation to patentability. Applicant has also added new Claims 35-40. Applicant respectfully requests reconsideration and allowance of all pending claims, and consideration and allowance of all new claims.

**I. The Claims are Allowable under 35 U.S.C. § 103(a)**

The Examiner rejects Claims 2-3, 5-7, 9-11, 15, 17-19, 24-26, 28-30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,311,438 to Sellers, et al. ("*Sellers*") in view of U.S. Patent 6,578,005 to Lesaint, et al. ("*Lesaint*"). Applicant respectfully disagrees.

**A. The Proposed *Sellers-Lesaint* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in the Claims**

First, Applicant respectfully submits that the proposed *Sellers-Lesaint* combination fails to disclose, teach, or suggest various limitations recited in Applicant's claims. The claims are allowable for at least this reason. Applicant discusses independent Claim 7 as an example.

*Sellers* merely discloses an integrated manufacturing system that utilizes a common database structure and product definition to achieve integration of multiple systems. (Abstract) The product definition includes an item and specification to define material or resources used in or related to a manufacturing process. (Abstract) The item identifies the material or resources, and the specification describes its performance specifications. (Abstract) Multiple manufacturing systems each use the same common database structure and product definition for processing data. (Abstract) A new product development system may also be integrated with the common database to facilitate and automate the process of developing new products. (Abstract) According to *Sellers*, since data is stored in the common database product definition during new product development, the data required for commercially producing *the product* is automatically linked to the systems required to set up the production run, which saves considerable time

between the finalization of *the new product* and the commercial availability of *the product*. (Column 4, Lines 1-7; emphasis added)

At the outset, Applicant notes that *Sellers* is not even directed to and does not disclose, teach, or suggest “*selecting a portfolio of products to be developed*.” Instead, *Sellers* merely discusses development of a single new product. Applicant respectfully submits that this distinction is fatal to the Examiner’s application of *Sellers* to Applicant’s claims, as Applicant demonstrates below.

In addition, *Sellers* fails to disclose, teach, or suggest at least the following limitations recited in Claim 7:

- using the computer system, selecting *a set of candidate products* to be developed;
- using the computer system, calculating a set of financial projections *for each candidate product*, the set of financial projections for a candidate product providing a future profit determination *for each of a set of possible product introduction dates for the candidate product*;
- using the computer system, *for each candidate product*, determining based on the set of financial projections an impact that the time of introduction has on profits associated with the candidate product;
- using the computer system, *providing at least one project definition for each candidate product*, such project definitions each including a development schedule and resource requirements; and
- using the computer system, generating *a development schedule for the set of candidate products to maximize profit* based at least on the determined impact that the time of introduction has on profits associated with each of the candidate products and using the financial projections for the candidate products as a weighted factor in generating the development schedule such that *products more affected by time are scheduled for faster production than products less affected by time, the development schedule providing for product development in accordance with project definitions for each of the candidate products and resource constraints*.

For example, *Sellers* fails to disclose, teach, or suggest “*selecting a set of candidate products* to be developed,” as recited in Claim 7. As disclosing this limitation, the Examiner cites the following statement in *Sellers*: “The Create and Submit A Request conversation . . . may be used to define a request for a new product and submit the request to a selected business manager.” (Column 79, Lines 32-35; *see also* Office Action, Page 2) However, the cited portion

of *Sellers* clearly discloses only submitting a request for a single new product, not “selecting *a set of candidate products* to be developed,” as recited in Claim 7. This is related to the fact that *Sellers* is not even directed to “method for selecting a portfolio of products to be developed,” as recited in Claim 7 and as discussed above.

As another example, at least because *Sellers* fails to disclose, teach, or suggest “selecting *a set of candidate products* to be developed,” *Sellers* necessarily fails to disclose, teach, or suggest “calculating a set of financial projections *for each candidate product [in the set of candidate products]*, the set of financial projections for a candidate product providing a future profit determination for each of a set of possible product introduction dates for the candidate product,” as recited in Claim 7. Additionally, the portion of *Sellers* on which the Examiner relies discloses a Design Request Financial Analysis conversation to “create, maintain, and review various financial simulations associated with for [sic] a design request.” (Column 113, Lines 32-35; *see also* Office Action, Page 3) In relevant part, the cited portion discloses that a list screen displays all of the financial simulations currently defined in the system. (column 113, Lines 36-37) “[The] first detail screen in this conversation [is used] to document the expected investment outlays and estimated operating cash flows over the entire economic life of the new product. Also document the cash flows on this screen.” (Column 113, Lines 38-43) *Sellers* further discloses that “the second detail screen contains results of a present value analysis applied to the estimates entered on the first screen. This analysis provides some basic financial parameters such as the net present value, profitability index, internal rate of return, and the present value payback period.” (Column 113, Lines 44-49) Assuming for the sake of argument that the “profitability index” disclosed in *Sellers* could be equated with the future profit determination recited in Claim 7, as proposed by the Examiner, *Sellers* would still fail to disclose, teach, or suggest “the set of financial projections for a candidate product providing a future profit determination *for each of a set of possible product introduction dates for the candidate product*,” as recited in Claim 7.

As another example, *Sellers* fails to disclose, teach, or suggest “*generating a development schedule for the set of candidate products to maximize profit . . . such that products more affected by time are scheduled for faster production than products less affected*

*by time, the development schedule providing for product development in accordance with the project definitions for each of the candidate products and resource constraints,”* as recited in Claim 7 as amended. The Examiner relies on three separate portions of *Sellers* as disclosing this limitation.

The first portion discloses that the purpose of an item/specification screen is “[t]o browse physical specification information for an item/spec. Also use this screen to review test specifications for an item. Item/spec information is used throughout the system in functions such as inventory, production scheduling, order processing, and shipping.” (Column 87, Lines 17-23) *Sellers* defines an item as “the various resources used in a manufacturing process to produce one or more end products.” (Column 3, Lines 17-19) With regard to specifications, *Sellers* discloses that “[e]ach item [i.e. resource] is linked to one or more sets of specifications” and that the “specification may include performance characteristics of the particular item, and these performance characteristics define the item.” (Column 3, Lines 17-23) Thus, the first portion of *Sellers* on which the Examiner relies discloses nothing more than browsing information about a resource.

The second portion of *Sellers* on which the Examiner relies as disclosing this limitation discloses that the purpose of a design request financial analysis screen is “[t]o browse the results of a present value analysis applied to the estimated investments and cash flows. These results include the net present value, profitability index, and internal rate of return. Also use this screen to review financial comments and estimated costs.” (Column 89, Lines 4-10) Thus, the second portion of *Sellers* on which the Examiner relies merely discloses reviewing some financial information associated with the design of a single product whose design is being evaluated.

The third portion of *Sellers* on which the Examiner relies as disclosing this limitation discloses a screen for maintaining a project definition for a requested new product. (Column 91, Line 1 and Column 107, Lines 4) In particular, the cited portion states, “The Project Definition conversation . . . may be used to review and maintain information that defines the product development effort. This information includes the project leader, request priority, targeted commercial location and line, and design category.” (Column 107, Lines 5-9) This disclosure

merely references the phrase “product development effort” and provides no details for what that phrase means. It certainly does not disclose, teach, or suggest, even when considered along with the Examiner’s other two citations, “generating *a development schedule for the set of candidate products to maximize profit . . . such that products more affected by time are scheduled for faster production than products less affected by time, the development schedule providing for product development in accordance with the project definitions for each of the candidate products and resource constraints,*” as recited in Claim 7 as amended. There simply is no development schedule generated for a set of candidate products to maximize profits disclosed in the cited portions of *Sellers*.

Moreover, since *Sellers* fails to disclose, as the Examiner acknowledges, “for each candidate product, determining based on the set of financial projections an impact that the time of introduction has on profits associated with the candidate product” and “maximizing profit based at least on the determined impact that the time of introduction has on profits associated with each of the candidate products and using the financial projections as a weighted factor in generating the development schedule” (See Office Action, Page 4), *Sellers* necessarily fails to disclose, teach, or suggest “generating *a development schedule for the set of candidate products to maximize profit . . . such that products more affected by time are scheduled for faster production than products less affected by time,*” as recited in Claim 7 as amended.

As another example, the Examiner correctly acknowledges that *Sellers* “fails to disclose using the computer system, for each candidate product, determining based on the set of financial projections an impact that the time of introduction has on profits associated with the candidate product, or maximizing profit based at least on the determined impact that the time of introduction has on profits associated with each of the candidate products and using the financial projections as a weighted factor in generating the development schedule [such that] products more affected by time . . . .” (Office Action, Page 4) However, the Examiner argues that *Lesaint* does disclose these limitations. Applicant respectfully disagrees.

*Lesaint* merely discloses a method and apparatus for resource allocation when schedule changes are incorporated in real time. The resources contemplated by *Lesaint* are service

operatives (i.e. service technicians). (Abstract; Column 11, Lines 35-43; Figure 1, T1-T3)) In other words, *Lesaint* merely discloses a technique for scheduling tasks to service technicians (e.g., the allocation of tasks to a field force of personnel such as ambulance or taxi drivers, a vehicle repair call-out field force, or a maintenance field force for a distributed system such as an electricity or water supply system or a telecommunications network). (See Column 1, Lines 14-19)

Like *Sellers*, *Lesaint* is unrelated to “*selecting a portfolio of products to be developed*,” as recited in Claim 7. Thus, in contrast to the Examiner’s position, *Lesaint* fails to disclose, teach, or suggest “*for each candidate product, determining based on the set of financial projections an impact that the time of introduction has on profits associated with the candidate product*,” “*maximizing profit based at least on the determined impact that the time of introduction has on profits associated with each of the candidate products and using the financial projections for the candidate products as a weighted factor in generating the development schedule such that products more affected by time are scheduled for faster production than products less affected by time*,” as recited in Claim 7. (See Office Action, Pages 4-5)

Given that *Lesaint* does not appear to even relate to “*selecting a portfolio of products to be developed*,” *Lesaint* necessarily fails to disclose, teach, or suggest “*for each candidate product, determining based on the set of financial projections an impact that the time of introduction has on profits associated with the candidate product*,” as recited in Claim 7.

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The Examiner relies on a portion of *Lesaint*, which states “at any time priority will be given to tasks that can be done immediately and . . . to the tasks with the greatest importance score.” (Column 13, Lines 7-9; see also Office Action, Page 5) The Examiner further states, “*Lesaint et al discloses this limitation in an analogous art for the purpose of showing that the product schedules can be developed according to certain time constraints*.” However, as Applicant has repeatedly demonstrated, *Lesaint* is unrelated to product schedules. While *Lesaint* may discuss constraints in developing a schedule for service technicians, it does not disclose, teach, or suggest the limitations specifically recited in Claim 7 (and lacking in *Sellers*),

particularly, “*using the computer system, for each candidate product, determining based on the set of financial projections an impact that the time of introduction has on profits associated with the candidate product, or maximizing profit based at least on the determined impact that the time of introduction has on profits associated with each of the candidate products and using the financial projections as a weighted factor in generating the development schedule [such that] products more affected by time,*” as recited in Claim 7.

For at least these reasons, Applicant respectfully submits that the proposed *Sellers-Lesaint* combination fails to disclose, teach, or suggest various limitations recited in independent Claim 7.

For substantially similar reasons, Applicant respectfully submits that the proposed *Sellers-Lesaint* combination fails to disclose, teach, or suggest various limitations recited in independent Claims 15, 26, and 34.

**B. The Proposed *Sellers-Lesaint* Combination is Improper**

The rejection of Applicant's claims is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Sellers*, *Lesaint*, or knowledge generally available to those of ordinary skill in the art at the time of the invention to modify or combine *Sellers* or *Lesaint* in the manner the Examiner proposes. The rejected claims are allowable for at least this reason.

Applicant respectfully submits that the Examiner's assertion that it would have been obvious to combine the teachings of *Sellers* with the teachings of *Lesaint* to arrive at Applicant's invention is insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention

taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Sellers-Lesaint* combination does not, taken as a whole, suggest the claimed invention, taken as a whole.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.<sup>1</sup> According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-*

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<sup>1</sup> Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").



*Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a

hindsight syndrome wherein that which only the invention taught is used against its teacher." *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a sufficient motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

With respect to the proposed *Sellers-Lesaint* combination, the Examiner states, "It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to use weighted factors in generating the development schedule such that products more affected by time are scheduled for faster production *with the motivation of processing tasks that can be done immediately first.*" (Office Action, Page 5; emphasis added) First, even assuming that the proposed combination of references is possible and that the Examiner's proposed motivation were actually taught in either of the cited references, it is not clear what relation this proposed motivation would have with respect to Applicant's claims. In particular, Applicant respectfully disagrees that incorporating "weighted factors in generating the development schedule such that products more affected by time are scheduled for faster production" into *Seller's* system would result in "processing tasks that *can* be done immediately first," as asserted by the Examiner. (Office Action, Page 5; emphasis added) On the contrary, incorporating "weighted factors in generating the development schedule such that products more affected by time are scheduled for faster production" would likely result in scheduling those tasks that should be scheduled first (i.e.

because they are more affected by time) being scheduled before tasks that are less affected by time (i.e. because they are less affected by time). In any event, the Examiner has not pointed to any portions of either *Sellers* or *Lesaint* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the particular system disclosed in *Sellers* with the particular system disclosed in *Lesaint*. It is not clear why one of ordinary skill in the art at the time of invention would even attempt to, let alone actually, incorporate the technician-scheduling system disclosed in *Lesaint* into the integrated manufacturing system disclosed in *Sellers*.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Sellers* with *Lesaint* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicant respectfully submits that the Examiner's proposed combination of *Sellers* with *Lesaint* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicant's claims and is unsupported by the teachings of *Sellers* and *Lesaint*. Applicant respectfully submits that the rejections must therefore be withdrawn.

Second, as demonstrated above, Applicant respectfully submits that *Sellers* is wholly inadequate as a reference against independent Claim 1, for example. Thus, even if *Lesaint* disclosed the portions of Claim 1 that the Examiner suggests (which, as discussed above, it does not), and even if there was the required teaching, suggestion, or motivation to combine *Sellers* with *Lesaint* as the Examiner proposes, the proposed *Sellers-Lesaint* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 1, for example, as is required under the M.P.E.P. and the governing Federal Circuit cases for a *prima facie* case of obviousness.

### **C. Conclusion**

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 7, 15, 26, and 34 and their dependent claims.

## **II. The Dependent Claims are Allowable**

The Examiner rejects Claims 8, 14, 16, 22, 27, and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Sellers* in view of *Lesaint* and U.S. Patent 6,671,673 to Baseman et al. ("*Baseman*"). The Examiner rejects Claims 12-13, 20-21, and 31-32 under 35 U.S.C. § 103(a) as being unpatentable over *Sellers* in view of *Lesaint* and U.S. Patent 5,408,663 to Miller ("*Miller*").

Dependent Claims 8 and 12-14, dependent Claims 16 and 20-22, and dependent Claims 27 and 31-33 depend from independent Claims 7, 15, and 26, respectively, which Applicant has shown above to be clearly patentable over the proposed *Sellers-Lesaint* combination. Neither *Baseman* nor *Miller* make up for the deficiencies of the proposed *Sellers-Lesaint* combination, discussed above with respect to independent Claims 7, 15, 26, and 34. Thus, dependent Claims 8 and 12-14, dependent Claims 16 and 20-22, and dependent Claims 27 and 31-33 are allowable at least because of their dependence on independent Claims 7, 15, and 26.

Furthermore, in addition to those reasons discussed above with reference to independent Claims 7, 15, and 26, dependent Claims 8, 12-14, 16, 20-22, 27, and 31-33 recite further patentable distinctions over the Examiner's proposed combination of references. To avoid burdening the record, Applicant does not specifically discuss those distinctions in this Response. However, Applicant reserves the right to discuss those distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicant does not admit that the proposed combination of *Sellers*, *Lesaint*, and *Baseman* and the proposed combination of *Sellers*, *Lesaint*, and *Miller* are possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 8, 12-14, 16, 20-22, 27, and 31-33.

## **III. New Claims 35-40 are Allowable**

In addition to being dependent on allowable independent claims, new Claims 35-36 (which depend from independent Claim 7), new Claims 37-38 (which depend from independent

Claim 15), and new Claims 39-40 (which depend from independent Claim 26) recite further patentable distinctions over the prior art of record.

For example, the proposed *Sellers-Lesaint* combination fails to disclose, teach, or suggest the following limitations recited in Claim 35:

- the set of candidate products define a first product mix;
- the generated development schedule for the first product mix comprises a first development schedule; and
- the method further comprises:
  - generating as an output a first projected profit number for the first product mix in addition to generating the first development schedule;
  - changing, after generating the first development schedule for the first product mix and generating the first projected profit number for the first product mix, the set of candidate products in the first product mix to define a second product mix;
  - generating a second development schedule for the second product mix;
  - and
  - generating as an output a second projected profit number for the second product mix in addition to generating the second development schedule, enabling a user to compare the first development schedule and the second development schedule and to compare the first projected profit number and the second projected profit number to determine whether the first product mix or the second product mix is suitable.

New Claims 37 and 39 recite substantially similar limitations.

For at least these reasons, Applicant respectfully requests consideration and allowance of new Claims 35-40.

#### **IV. No Waiver**

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

**Conclusion**

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

A check in the amount of \$54.00 is enclosed to cover the cost of three new claims total over twenty. The Commissioner is hereby authorized to charge any other fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicant



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Date: October 7, 2004

Customer No.

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